



10/673121

6-25-07

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EXPRESS MAIL NO.: EV 811 560 674 US

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent No.: 7,220,771 B2 (U.S. application no. 10/673,121, filed September 26, 2003)

Issued: May 22, 2007

Inventor(s): Bhagwat et al.

For: METHODS OF USING INDAZOLE DERIVATIVES AS JNK INHIBITORS

Attorney Docket No.: 10624-133-999

(CAM: 700755-999132)

**REQUEST FOR CERTIFICATE OF CORRECTION  
UNDER 37 C.F.R. §1.322****Attention Certificate of Correction Branch**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**Certificate  
JUN 27 2007  
of Correction**

Sir:

Patentee hereby respectfully requests the issuance of a Certificate of Correction in connection with the above-identified patent. The correction is listed on the attached Form PTO-1050.

The error was made by the United States Patent and Trademark Office ("USPTO") in connection with the above patent, wherein at:

Claim 1, column 322, line 30, please replace "R<sub>2</sub>" with -- R<sub>8</sub> --.

Enclosed is a copy of a Notice of Allowance and Fee(s) Due and Notice of Allowability mailed by the USPTO in connection with the above-identified patent application on December 28, 2006 evidencing the correction as set forth above. In particular, pages 2 and 3 of the Notice of Allowability correctly set forth issued claim 1 and correctly recite R<sub>8</sub> at the location described above.

**JUN 27 2007****JUN 27 2007**

No fee is believed to be due in connection with this request since the error was made by the USPTO. Should any fee be required, however, please charge such fee to Jones Day Deposit Account No. 50-3013. Please issue a certificate of correction as soon as possible.

Date: June 22, 2007

Respectfully submitted,

*Anthony M. Insogna, Reg. No. 35,203*  
*By: Michael J. Bruner, Reg. No. 47,458*  
By: Michael J. Bruner (Reg. No. 47,458)

**JONES DAY**

222 East 41st Street

New York, New York 10017

(212) 326-3939

For: Anthony M. Insogna (Reg. No. 35,203)

**JONES DAY**

12265 El Camino Real, Suite 200

San Diego, California 92130

(858) 314-1130

JUN 27 2007

# UNITED STATES PATENT AND TRADEMARK OFFICE

## CERTIFICATE OF CORRECTION

PATENT NO. : 7,220,771 B2  
 DATED : May 22, 2007  
 INVENTOR(S) : Bhagwat et al.

It is certified that an error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

At Claim 1, column 322, line 30, please replace " $R_2$ " with --  $R_8$  --.

JUN 27 2007

MAILING ADDRESS OF SENDER:  
**JONES DAY**  
 222 East 41st Street  
 New York, New York 10017  
 (858) 314-1130  
 ATI-2276797v1  
 FORM PTO 1050

PATENT NO. 7,220,771 B2

No. of add'l. copies  
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NOTICE OF ALLOWANCE AND FEE(S) DUE

20583 7590 12/28/2006

JONES DAY  
222 EAST 41ST ST  
NEW YORK, NY 10017

EXAMINER	
KIM, JENNIFER M	
ART UNIT	PAPER NUMBER

1617  
DATE MAILED: 12/28/2006

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,121 09/26/2003 Shripad S. Bhagwat 10624-133-999 1280

TITLE OF INVENTION: INDAZOLE DERIVATIVES AS JNK INHIBITORS AND COMPOSITIONS AND METHODS RELATED THERETO

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1400	\$300	\$0	\$1700	03/28/2007

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.
- B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

- A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

JUN 27 2007

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

# **PART B - FEE(S) TRANSMITTAL**

Complete and send this form, together with applicable fee(s), to: **Mail** Mail Stop ISSUE FEE  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, Virginia 22313-1450**  
**or Fax** (571)-273-2885

**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

20583 7590 12/28/2006

JONES DAY  
 222 EAST 41ST ST  
 NEW YORK, NY 10017



Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

**Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,121 09/26/2003 Shripad S. Bhagwat 10624-133-999 1280

TITLE OF INVENTION: INDAZOLE DERIVATIVES AS JNK INHIBITORS AND COMPOSITIONS AND METHODS RELATED THERETO

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
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nonprovisional NO \$1400 \$300 \$0 \$1700 03/28/2007

EXAMINER	ART UNIT	CLASS-SUBCLASS
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KIM, JENNIFER M 1617 514-403000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
- ☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively,
- (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1	_____
2	_____
3	_____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

JUN 27 2007

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee
- ☐ Publication Fee (No small entity discount permitted)
- ☐ Advance Order - # of Copies \_\_\_\_\_

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_

Date \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Registration No. \_\_\_\_\_

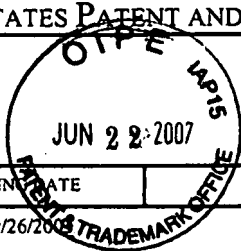
This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,121	09/26/2006	Shripad S. Bhagwat	10624-133-999	1280

20583

7590

12/28/2006

JONES DAY  
222 EAST 41ST ST  
NEW YORK, NY 10017

EXAMINER

KIM, JENNIFER M

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 12/28/2006

## Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 0 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

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# Notice of Allowability

Application No.

10/673,121

Examiner

Jennifer Kim

Applicant(s)

BHAGWAT ET AL.

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to August 24, 2006 & 11/30/2006.
2. ☒ The allowed claim(s) is/are 78, 80-82 (1, 2-4).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

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## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date 8/24/2006
- ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
- ☐ Notice of Informal Patent Application
- ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
- ☒ Examiner's Amendment/Comment
- ☒ Examiner's Statement of Reasons for Allowance
- ☐ Other \_\_\_\_\_

JUN 27 2007



Application/Control Number: 10/673,121  
Art Unit: 1617

Page 2

### DETAILED ACTION

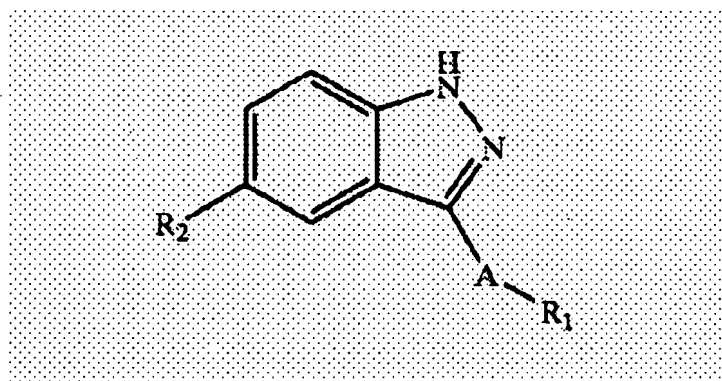
An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Michael Bruner on November 30, 2006.

The application has been amended as follows:

Claim 78 has been **replaced** with

"A method for treating cancer of the blood, brain, lung or prostate by inhibiting JNK pathway comprising administering to a patient in need thereof an effective amount of a compound having the structure:



or a pharmaceutically acceptable salt thereof, wherein:

A-R<sub>1</sub> is phenyl, optionally substituted with one to four substituents

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independently selected from halogen, alkoxy,  $-\text{NR}_8\text{C}(=\text{O})\text{R}_9$ ,

$-\text{C}(=\text{O})\text{NR}_8\text{R}_9$ , and  $-\text{O}(\text{CH}_2)_b\text{NR}_8\text{R}_9$ ;

$\text{R}_2$  is 3-triazolyl or 5-tetrazolyl;

$b$  is 2 or 3;

$\text{R}_8$  and  $\text{R}_9$  are the same or different and at each occurrence independently

hydrogen, alkyl, aryl, arylalkyl, heterocycle, or heterocyclealkyl, or

$\text{R}_8$  and  $\text{R}_9$  taken together with the atom or atoms to which they are

bonded from a heterocycle, wherein each of  $\text{R}_8$ ,  $\text{R}_9$ , and  $\text{R}_8$  and  $\text{R}_9$

taken together to form a heterocycle are optionally substituted with

one to four substituents independently selected from  $\text{R}_3$ ;

$\text{R}_3$  is at each occurrence independently halogen, hydroxy, carboxy, alkyl,

alkoxy, haloalkyl, acyloxy, thioalkyl, sulfinylalkyl, sulfonylalkyl,

hydroxyalkyl, aryl, substituted aryl, arylalkyl, substituted arylalkyl,

heterocycle, substituted heterocycle, heterocyclealkyl, or

substituted heterocyclealkyl."

#### Reasons for allowance

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The following is an examiner's statement of reasons for allowance:

1. The changes to radical  $\text{R}_3$  made by Examiner's amendment are editorial in nature.

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2. To improve clarity of the claims the specific pathway has been included.
3. The changes made by Examiner's amendment are not made to avoid any rejections based upon prior art.
4. The claims are allowable over the cited prior art because the prior art does not teach, disclose nor make obvious the claimed method for inhibiting the JNK pathway comprising administering to a patient in need thereof an effective amount of a compound having the structure set forth in claim 78, wherein the administration treats cancer of the blood, brain, lung or prostate.
5. The claimed method of inhibiting the JNK pathway thereby treating cancer of the blood, brain, lung or prostate by administration of the compound having structure set forth in claim 78 is novel because instant compounds to be utilized are claimed in Applicant's parent patent 6,897,231. (see the claims).
6. Applicants overcome the rejection under 35 U.S.C. 112, first paragraph for lacking enablement, by Applicant's persuasive argument and submission of references showing the nexus between inhibition of the JNK pathway and the claimed **specific** cancer.
7. Pursuant to MPEP 804, since the only remaining rejection is the obvious type double patenting (ODP) rejection, the instant ODP rejection is withdrawn over 10/718,185.
8. Any comments considered necessary by applicants must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

JUN 27 2007

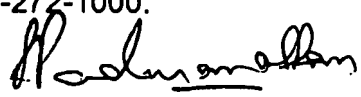
Art Unit: 1617

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Sreenivasan Padmanabhan  
Supervisory Primary Examiner  
Art Unit 1617

JUN 27 2007

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